

**REMARKS**

This response is being mailed with a two month request for extension of time to respond to the Official Action dated November 22, 2004, extending the deadline for making the response until April 22, 2005; as such, this response is timely.

**Claim Rejections - 35 USC §101**

Claim 17 is rejected under 35 §101 as being directed to non-statutory subject matter. The Official Action asserts that these claims are rejected because "none of the recited steps are directed to anything in the technological arts as ... with the exception of the recitation in the preamble that the method is "computer implemented." As provided below, Applicant respectfully traverses this rejection. In short, 35 USC §101 explicitly recognizes a "process" as a proper statutory category that is protectable by patent. Applicant is aware of no requirement that a process must be claimed as a "computer implemented method." Indeed, many process claims have been issued by the US Patent Office that are not directed to computer implemented methods. Applicant is certainly aware of no requirement that the body of a method claim must include the "computer implemented" feature. Thus, because the preamble of the present claims specify that they are directed to a process (i.e., a method), and more particularly to a "computer implemented method," Applicant respectfully submits that these claims are directed to proper statutory subject matter in accordance with 35 USC §101. Further, Applicant respectfully submits that even if features recited in the preamble are not given patentable weight, the preamble can be used for determining the statutory category to which the claim is directed.

35 USC §101 provides: "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title" (emphasis added). MPEP §2106.IV.A. explains that 35 USC 101 defines four categories of inventions that Congress deemed to be the appropriate subject matter of a patent; namely, processes, machines, manufactures and compositions of matter. The latter three categories define "things" while the first category defines "actions" ... See 35 USC §100(b) ("The term 'process' means process, art, or method, and includes a new use of a known process, machine manufacture, composition of matter, or material."). Thus, a process is recognized specifically by 35 USC §101 as appropriate subject matter of a patent. As such, Applicant respectfully submits that claims 1-2 (new Claims 3-4) fall within this recognized category of appropriate patentable subject matter. Accordingly, 35 USC §101 provides that Applicant "may obtain a patent therefor, subject to the conditions and requirements" of title 35 USC.

As the Supreme Court has held, Congress chose the expansive language of 35 USC §101 so as to include "anything under the sun that is made by man." *Diamond v. Chakrabarty*, 447 US 303, 308-

09, 206 USPQ 193, 197 (1980). MPEP §2106.IV.A. further explains that the "subject matter courts have found to be outside the four statutory categories of invention is limited to abstract ideas, laws of nature and natural phenomena" (emphasis added). "These three exclusions recognize that subject matter that is not a practical application or use of an idea, a law of nature or a natural phenomena is not patentable." MPEP §2106.IV.A. (emphasis in original).

It appears that the Official Action in asserting that "the technological arts recited in the preamble ... does not confer statutory subject matter to an otherwise abstract idea" is effectively alleging that the method of Claim 17 recites an abstract idea. In other words, the Official Action appears to assert that unless a computer implementation is specifically recited for performing the method steps, the recited method is merely an abstract idea. Under this logic, the statutory category of "process" that is specifically recognized by 35 USC §101 is actually only proper if a claimed process is recited as being implemented by a computer. Applicant is not aware of any such restriction on this statutory category. Indeed, as described hereafter, the present claims are not directed to an abstract idea, irrespective of whether the recited elements are implemented in a computer.

For example, Claim 17 specifically recites "obtaining a first scenario set comprising at least two scenarios and a specified available cash and a specified quantity of another resource, optimizing said specified available cash and said specified quantity of another resource in said first scenario set, obtaining a second scenario set comprising at least two scenarios and a specified available cash and a specified quantity of another resource, optimizing said specified available cash and said specified quantity of another resource in said second scenario set, evaluating differences in said cash resource and said another resource allocations in said at least two scenario sets to obtain a valuation of said another resource, passing result of said valuation of said another resource to a computer program routine for subsequent handling." Claim 17 does not merely recite an abstract idea, but instead positively recites various actions to be performed in the claimed method (e.g., obtaining, optimizing, evaluating, and passing).

MPEP §2106 provides that a "process that consists solely of the manipulation of an abstract idea is not concrete or tangible", and it further explains that "[o]ffice personnel have the burden to establish a prima facie case that the claimed invention as a whole is directed to solely an abstract idea." In the present case, the Examiner has failed to properly establish such a prima facie case. Indeed, the Examiner offers no reasoning as to why the recited process of claim 17 is asserted to be directed to an abstract idea other than asserting that the claims do not show any structure or functionality to suggest that a computer performs the recited steps.

Again, Applicant is aware of no requirement that a process be implemented in a computer in order to be proper statutory subject matter under US Patent laws.

MPEP §2106 further explains, with regard to the issue of whether a claim is directed to an abstract idea, that "only when the claim is devoid of any limitation as to a practical application in the technological arts should it be rejected under 35 USC §101." Applicant respectfully submits that claim 17 is not properly rejected in this regard because they recite subject matter that is a "practical application" within the technological arts.

MPEP §2106 also directs that when a claim is rejected as being directed to merely an abstract idea, "Office personnel must expressly state how the language of the claims has been interpreted to support the rejection." Thus, if this rejection is maintained in the next Official Action, Applicant respectfully requests that the Examiner more clearly set forth the reasoning for such rejection in accordance with the directives of the MPEP. Additionally, if the Examiner asserts that the process must be recited as implemented in a computer, Applicant respectfully requests that the Examiner identify the authority upon which the Examiner relies for requiring a process to be so implemented.

In view of the above, Applicant respectfully submits that Claim 17 is directed to proper statutory subject matter in accordance with 35 USC §101, and thus withdrawal of this rejection is requested.

#### **Claim Rejections - 35 USC §103**

Claim 17 is rejected under 35 USC §103(a) as being unpatentable over Cheng et al. U.S. Patent No. 6,138,103. *Cheng* discloses a system and method for optimally allocating resources by employing a scenario based analysis including the steps of performing multiple optimization runs against different demand scenarios and for generating for any one individual demand scenario a deterministic solution which is optimal for the particular demand scenario (Col. 2, lines 29-62). *Cheng* does not mention resource valuation which Applicant's amended claims are specifically directed towards, thus *Cheng* either alone or in combination with other references would not render the amended claim obvious. Reconsideration is requested.

#### **Double Patenting Rejection**

In response to the Patent Office's nonstatutory double patenting rejection, the Applicant is enclosing a terminal disclaimer.

Appl. No. 10/656,395  
Amdt. dated April 12, 2005  
Reply to Office action of November 22, 2004

**Conclusion**

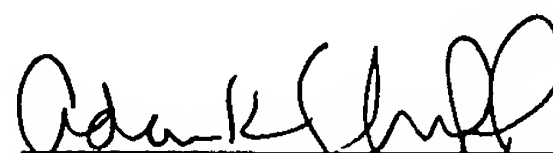
The Patent Office is authorized to charge the fees associated with the three-month extension of time and any additional fees associated with the filing of this response to deposit account 134825, with specific reference to 4000735.0022.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case. If the Office has any questions, please free feel to contact the undersigned at 312-521-2775.

Respectfully submitted,

Date: 4-12-2005

By:




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CERTIFICATE OF MAILING

I hereby certify that the enclosed Amendment and Response for Patent Application No. 10/656,395 and related documentation are being deposited with the United States Postal Service with sufficient postage addressed to: Commissioner for Patents and Trademarks, P.O. Box 1450, Alexandria, VA 22313-1450 on April 12, 2005.

  
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